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Dear Mr. President, A word on the composition of the Opposition Division – Part II

Dr. Malte Köllner · Wednesday, August 14th, 2024

This is part II of an open letter directed to the President of the EPO in his capacity to give directions on the composition of Opposition Divisions. Article 19 EPC explicitly permits the Primary Examiner to be member of an Opposition Division. Many applicants and representatives, however, have a feeling of bias in favour of the patentee before Opposition Divisions. This bias is perceived as a consequence of the participation of the Primary Examiner. In part II we showed that this feeling is justified. Article 19 leaves discretion to the office to call the Primary Examiner to the Opposition Division or not. I urge the President to give directions to the effect that this discretion should be used in a way as not to call the Primary Examiner to the Opposition Division.

7. Legal remedies

7.1 Roman law

An old roman principle reads: *Nemo iudex in sua causa*^[1] (None shall be a judge in their own cause).

It is not worth digging too deep into Roman law. Undoubtedly, opposition is *sua causa* for the Primary Examiner involved in grant. But is the Primary Examiner also *iudex*? Case law diverges as to the question whether opposition is a judicial procedure^[2] or simply an administrative procedure^[3].

7.2 International law

Article 6 of the European Convention on Human Rights (ECHR) calls for a fair trial in a timely manner.^[4]

A fair trial calls for impartial judges. There seems to be a consensus, that having the Primary Examiner sit in the Opposition Division violates the fundamental principle of impartiality and fair trial.^[5] Article 19 EPC only made an exception for reasons of procedural economy.

The European Court of Human Rights, however, did not generally allow balancing fair trial and procedural economy. Mainly in exceptional cases characterised by hopelessness or simple procedural matters would the European Court of Human Rights allow to balance fair trial and procedural economy.^[6] This is, however, not the general situation in opposition proceedings.

Thus, in normal opposition proceedings, efficiency of proceedings should not trump impartiality. In other words, we cannot tolerate impartiality in order to have more efficient proceedings. All the more so if in fact there are no gains in procedural economy.

As a consequence, Article 19 para. 2 EPC is hardly compatible with Article 6 ECHR. The only way to reconcile these two norms is to make use of the discretion left to the office in such a way as not to include the Primary Examiner into the Opposition Division.

7.3 UPC

Although we don't yet know exactly how the UPC will handle perceptions of bias, the Code of Conduct of Judges specifies in Article 5(3) that justifiable doubts as to a judge's impartiality may arise "if [...] k) the judge has publicly stated an opinion on a matter specifically pertaining to the case, unless it is a general statement without a direct link to the matter". Applying this principle to members of the OD in EPO proceedings, what opinion could more specifically pertain to a case than the act of having granted that case during examination? Even absent actual impartiality, justifiable doubts surely arise when the examiner that granted a patent is then asked to determine whether the patent should have been granted at all.[7]

7.4 National law

Can a look into national law in conjunction with Article 125 EPC help? Article 125 EPC allows taking into account the principles of procedural law generally recognised in the Contracting States in the absence of procedural provisions in the EPC.

First of all, there are clear procedural provisions in the EPC governing the composition of the Opposition Division. Only the use of the discretion whether to include the Primary Examiner or not is left open in the Convention.

Secondly, a look into national law does not produce any generally recognised principles. In Great Britain, there are no opposition proceedings. In Germany, the Primary Examiner is regularly part of the Opposition Division. In France, the examiner is explicitly excluded from being member of the Opposition Division.[8]

So, little help here.

7.5 Exclusion of the Primary Examiner?

Can we ask for exclusion of the Primary Examiner according to Article 24(1) EPC. This was the question dealt with in G 5/91. And the answer is very clear:

Headnote 1:

Although Article 24 EPC applies only to members of the Boards of Appeal and of the Enlarged Board of Appeal, the requirement of impartiality applies in principle also to employees of the departments of the first instance of the EPO taking part in decision-making activities affecting the rights of any party.

Headnote 6:

The question whether or not an objection to a member of an Opposition Division on the ground of suspected partiality is to be considered justified can only be decided upon in the light of the particular circumstances of each individual case. As recognised in the referring decision (see paragraph 5 of the Reasons for the Decision), such considerations involve factual questions of degree rather than points of law and are therefore not to be dealt with by the Enlarged Board of Appeal in the present context.

No other answer was to be expected from the Enlarged Board of Appeal, as we have Article 19 para. 2 EPC. A different result could only have been expected if we wouldn't have Article 19 in its present form or if there would have been a clear guideline from the president of the EPO not to admit a Primary Examiner as member of the Opposition Division.

Consequently, T 1647/15 held that there was no legal basis for automatically applying Art. 24(3) and (4) EPC to an Opposition Division with a Primary Examiner as member. No automatic exclusion of the Primary Examiner.

7.6 Narrow scope of Article 19 para. 2 EPC

It has become clear, that Article 19 para. 2 EPC is an exception to a general principle. Exceptions regularly have a narrow scope of application. A narrow way of applying Article 19 would be not to appoint the Primary Examiner as member. The next most narrow way of applying Article 19 would be not to appoint the Primary Examiner as rapporteur.

8. Proposals

In view of all the above, I urge you, Mr. President, to take steps in the following direction:

8.1 No member of the Examining Division should be a member of the Opposition Division

Article 19 para. 2 EPC offers the discretion to take such decisions. It would improve fairness of the trial, impartiality of the Opposition Division and efficiency of proceedings.

8.2 A former member of the Examining Division should not be Rapporteur in the Opposition Division

As argued above, if the Primary Examiner from the examination proceedings before grant is chosen as rapporteur (Primary Examiner) of the opposition, his influence would be greater than if they were only the observer of the Opposition Division. This is to be avoided. And this has been argued many times already during preparation of the EPC.[\[9\]](#)

8.3 Particularly problematic constellations

In T 1674/12 it was decided that involvement of the Primary Examiner in a divisional or parent application does not constitute a danger of impartiality.

In view of a narrow application of Article 19 para. 2 EPC, I urge, however, the office to avoid some particularly problematic constellations. Among these particularly problematic constellations, I count:

- a) if the Primary Examiner was involved in examination in one or more divisional or parent application;

- b) if the Primary Examiner handled Third-Party-Observations, namely if they involved the opponent;
- c) if the Primary Examiner was involved in opposition in one or more divisional or parent applications.

In these particularly problematic constellations, it is reasonable to assume that the Primary Examiner would find it hard to set aside the views they have already formed of the prior art and the interpretation of the claims, and that it would be difficult for them to consider the case afresh. The pre-emption from the previous cases appears to make it hard to objectively reassess, for example, the choice of the closest prior art, the assessment of reasonable expectation of success based on the facts of the case,

Nonetheless, even if they are capable of setting these views aside, there could always be a perception or concern for third parties that they might not have done so, and this alone speaks against including them as a member of the Opposition Division.

Conclusion

I would appreciate if these arguments and proposals would be taken into consideration, Mr. President.

Yours respectfully.

[1] https://en.wikipedia.org/wiki/Nemo_iudex_in_causa_sua

[2] G 9/91 and G 10/91, OJ 1993, 408 and 420

[3] G 7/91 and G 8/91, OJ 1993, 356 and 346; G 9/91, OJ 1993, 408

[4] applicable to the EPC, see D 11/91

[5] Benkard EPÜ/Thums, 4. Aufl. 2023, EPÜ Art. 19 Rn. 22

[6] European Court of Human Rights: Oral proceedings may be dispensed with: (a) in uncontested cases (e.g. Döry v. Sweden, no. 28394/95, paragraph 8 to 16); (b) after comprehensive written proceedings (Jussila v. Finland, paragraph 48); (c) in less important matters (Jussila v. Finland, paragraph 48), (d) if the matter is not of public interest (e.g. Döry v. Sweden, paragraph 37); (e) when only admissibility is at issue (e.g. Axen v. Germany, paragraph 28); (f) if only procedural issues are at stake (Kremzow v. Austria, no. 12350/86, paragraph 63); (g) simple questions of law (e.g. Speil v. Austria, paragraph 2); (h) in technically complex cases (e.g. Döry v. Sweden, paragraph 37); but also (i) procedural economy, court capacities (Fejde v. Sweden, no. 12631/87); (j) timely decisions, backlog in the case load (Micallef v. Malta, no. 17056/06, paragraphs 78); (k) ONE oral hearing at FIRST instance may suffice (e.g. Jussila v. Finland, no. 73053/01, paragraph 41); (l) in an appeal instance (Jussila v. Finland, paragraph 47)

[7] I thank the team of Carpmiels & Ransford, London, for directing my attention to this.

[8] Code de la propriété intellectuelle, Partie réglementaire, Article R613-44-5

[9] Travaux Préparatoires to the EPC 1973, Minutes of the Munich Diplomatic Conference for the Setting up of a European System for the Grant of Patents, Report on the meeting of the Main Committee II, Artikel 18(19), <https://link.epo.org/web/legal/epc/TP1973-Articles-1-51.zip>, page 84, par. 99; page 22, Comments by Unice, 2 April 1973, M/19

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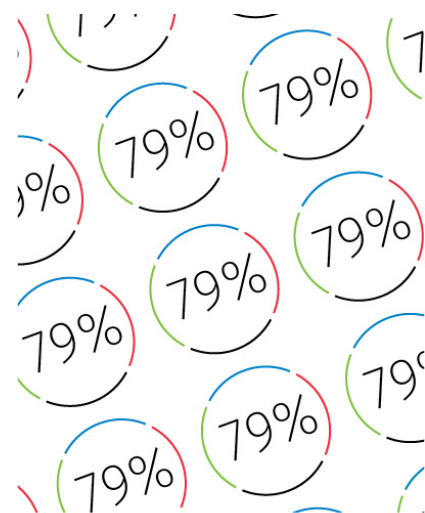
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